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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

Appellant : Tomonori FUJISAWA et al.

Title : INFORMING SYSTEM

Serial No. : 10/521,580

Filed : January 18, 2005

Group Art Unit : 2142

Examiner : Jason Recek

SECOND APPEAL BRIEF UNDER 37 CFR § 41.37

Date: March 11, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is filed pursuant to 37 CFR § 41.37. The previously paid Notice of Appeal Brief is applied to this new Appeal.

REAL PARTY IN INTEREST

The real party in interest is Kabushiki Kaisha Eighting, a Japanese corporation.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' representative, and the Assignee of this application are aware of no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

Prosecution was reopened as a result of the Appeal Brief filed August 11, 2008. This Appeal Brief is an appeal from the Office Action issued October 15, 2008.

STATUS OF CLAIMS

Claims 5 and 9 are pending in the application and stands rejected.

The rejection of claims 5 and 9 are appealed and is set forth in their entirety in the Claims Appendix attached hereto.

STATUS OF AMENDMENTS

The amendments to the claims, presented in the after final amendment filed April 28, 2008, have been entered.

No amendment is filed to the Office Action of October 15, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 5, supported by the specification as annotated below, recites an informing system comprising:

a service server (130) (see specification, page 6, lines 17-24, and Fig. 1) for relaying communications from an informing person (110) (see specification, page 6, lines 17-24, and Fig. 1) to informed persons (120-122) (see specification, page 6, lines 17-24, and Fig. 1),

terminal devices (111, 112; 121,122) (see specification, page 6, lines 17-24, and Fig. 1) owned by said informing person and said informed persons connected to each other via a computer network (140) (see specification, page 6, lines 17-24, and Fig. 1), and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter (see specification, page 7, line 3 to page 10, line 5, flowchart of Fig. 3),

wherein said service server (130) comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person (see page 12, line 19 to page 13, line 5, flowchart of Fig. 6), and

said reporting E-mail includes a plurality of choices for re-informing methods to the informed persons, said plurality of choices comprising placing a call to a first telephone number of informed persons

having not responded, and placing a call to a second telephone number of said informed persons having not responded (*see specification, page 14, line 19 to page 15, line 5, flowchart of Fig. 8, block 817*).

Independent claim 9, supported by the specification as annotated below, recites an informing system comprising:

a service server (130) for relaying communications from an informing person to informed persons (*see specification, page 6, lines 17-24, and Fig. 1*),

terminal devices (111, 112; 121, 122) owned by said informing person and said informed persons connected to each other via a computer network (140) (*see specification, page 6, lines 17-24, and Fig. 1*), and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person (*see specification, page 9, lines 1-2*), said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter (*see specification, page 10, lines 18-25*),

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person (*see page 12, line 19 to page 13, line 5, and flowchart of Fig. 6*), and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person (see page 12, line 9 to page 13, and flowchart of Fig. 6).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claim 5 stand rejected under 35 U.S.C. 103(a) over *Orime et al.* (JP 2002-183365 as translated) in view of *Felman* (US 2002/0152265).
- B. Claim 9 stand rejected under 35 U.S.C. 103(a) over *Orime et al.* in view of *Felman*.

ARGUMENT

A. Claim 5 is patentable under 35 U.S.C. §103(a)

Claim 5 recites transmitting a reporting E-mail to an informing person, the E-mail includes a plurality of choices for re-informing informed persons who have not responded, the plurality of choices includes: placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded. The Office Action of October 15, 2008 acknowledges that the disclosure of *Orime* is incomplete and relies upon *Hasebe* to allegedly remedy the deficiencies of *Orime*.

Specifically, the Office Action acknowledges that *Orime* fails to disclose the "wherein said reporting E-mail includes a plurality of choices for re-informing methods...choices comprising placing a call to a first telephone." The Office Action alleges that *Felman*, at paragraph 51, makes up for this deficiency by

teaching a system that sends an email containing a telephone number. The Office Action further posits that "[a]lthough *Felman* does not explicitly teach sending multiple telephone numbers this would have been obvious since the purpose of the invention to is [sic] get in contact with someone and there is a greater chance of success if all of their contact information is available." Appellants respectfully disagree.

First, the asserted combination of references does not teach or suggest all of Appellants' claim features.

Second, the combination of *Orime* and *Felman*, taken as a whole, do not suggest Appellants' claimed informing method, and constitute an improper reconstruction of Appellants' claimed invention.

The disclosures of *Orime* and *Felman* do not teach or suggest all of Appellants' claim features

The Examiner appears to rely on *Felman* to disclose transmitting a result of detecting a result entry by the informed persons as a reporting E-mail to the terminal device owned by said informing person, wherein the reporting E-mail includes a plurality of choices for re-informing methods to the informed persons, the plurality of choices comprising "placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded," (Emphasis added). Nowhere does *Felman* suggest a system whereby the system places a call.

In paragraph [0051] cited by the Examiner, *Felman* describes wherein a querying party may request via a server an e-mail address or phone number of a friend. The server e-mails or

calls the friend and prompts the friend that he has received a query for personal information and identifies the caller. The friend sends a consent/no consent signal to the server and based upon a consent signal, the server either transmits the requested information to the querying party. Appellants respectfully submit that paragraph [0051] only suggests transmitting a phone number to a querying party and nowhere suggests the actual act of placing a call, as recited in claim 5.

Furthermore, Appellants respectfully submit that the recited method of reinforming an informed party is clearly unrelated to the method of releasing information disclosed by *Felman*. Indeed, Appellants respectfully submit that the two inventions are so distinct as to make it difficult to determine which of the querying party (Tom) or the listing party (Sam) may be characterized as the recited informed persons or informing person. *Felman* appears to only disclose wherein a querying party requests information, and a listing party giving authorization for that release. Indeed, *Felman* discloses wherein information is only released when the listing party responds, which is distinguished from Appellants' method that provides the information when a party cannot be reached. In other words, Appellants' reinforming method applies when the informed party is not reached, not when they are reached, as disclosed by *Felman*.

Still further, there is no interaction between two parties at the Appellants' reinforming step, wherein the informing party automatically receives the contact information of a person to be informed if that person has not responded. Notwithstanding the Appellants' position that *Felman* is completely unrelated to the instant method, *Felman* only releases contact information upon receipt of a confirmation, and still further, fails to provide

the querying party the ability to automatically place a call based upon the received contact information.

Appellants respectfully submit that claim 5 is patentable at least due to the failure of *Orime* in view of *Felman* to disclose, teach or motivate all recited features of the claims.

The combination of *Orime* and *Felman* represent an improper reconstruction of Appellants' claimed invention

The Office Action further alleges that, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a telephone number over email as taught by *Felman* for the purpose of attempting to contact an invitee who has not responded, the motivation to combine being to allow the organizer to easily retry the users who had not confirmed.

Appellants respectfully disagree and submit that the combination of *Orime* and *Felman* is improper, and appears to be based on hindsight reasoning. Appellants respectfully submit that *Orime's* method of informing an informer as to who has not responded is unrelated to *Felman's* method of authorizing the release of requested information when the listed party is contacted. Appellants submit therefore that neither reference suggests the desirability of combining such teachings. It is improper to use the claimed invention as an instruction manual to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Office Action appears to use improper hindsight reconstruction to pick and choose among isolated disclosures. Accordingly, it is respectfully submitted that the combination is improper.

Accordingly, withdrawal of this rejection is respectfully requested.

B. Claim 9 is patentable under 35 U.S.C. §103(a)

Claim 9 is similar to claim 5, reciting, *inter alia*:

"wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person." (Emphasis added).

As presented above regarding claim 5, nowhere does *Felman* appear to disclose, teach, or suggest transmitting a reporting e-mail to the informer with a plurality of choices for re-informing a member when the member is not contacted. *Felman's* querying person only receives information when the listed member is contacted. Indeed, nowhere do either *Orime* or *Felman* disclose, teach, or suggest sending contact information of a party to be informed to the informer when the party to be informed does not respond. Appellants respectfully submit that Appellants' reinforming method is distinguished from the methods of *Orime* and *Felman*.

Furthermore, as recited in claim 9, the list of informed persons not having checked a transmitted message is prepared, and the list is periodically sent to the informing person.

Nowhere does *Felman* disclose or suggest retransmitting information.

Accordingly, the rejection of claim 9 under 35 U.S.C. §103(a) is improper and Appellant respectfully submits, therefore, that

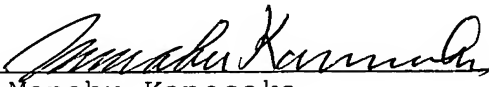
independent claim 9 is patentable over the applied art and the rejection should be reversed.

CONCLUSION

Accordingly, Appellants respectfully submits that the rejection of claims 5 and 9 are in error, and request that the final rejection be reversed.

Respectfully submitted,

KANESAKA BERNER & PARTNERS

By 
Manabu Kanesaka
Reg. No. 31,467
Agent for Appellant

1700 Diagonal Road, Suite 310
Alexandria, VA 22314
(703) 519-9785

CLAIMS APPENDIX

5. A informing system comprising:

a service server for relaying communications from an informing person to informed persons,

terminal devices owned by said informing person and said informed persons connected to each other via a computer network, and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter,

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

said reporting E-mail includes a plurality of choices for re-informing methods to the informed persons, said plurality of choices comprising placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded.

9. A informing system comprising:

a service server for relaying communications from an informing person to informed persons,

terminal devices owned by said informing person and said informed persons connected to each other via a computer network, and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter,

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person.

EVIDENCE APPENDIX

No copies of evidence are appended hereto.

RELATED PROCEEDINGS APPENDIX

No copies of decisions are appended hereto.